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Applicant: Arno Kleinhaeni and Roman Mathiuet
Serial No.: 10/018,060 Art Unit: N/A
Filed: December 10, 2001 Confirmation No.: 1183
I.A. No.: PCT/CH01/00207
I.A. Filed: April 2, 2001
Title: SECURITY REVERSIBLE KEY AND LOCKING SYSTEM
Examiner: N/A Docket No.: FRR-12782

REQUEST FOR RECONSIDERATION
(In Response to Notification of Defective Reply)

Assistant Commissioner for Patents
BOX PCT
ATTN: Office of PCT Legal Administration
Washington, D.C. 20231

Sir:

This request for reconsideration is filed in response to the Notification of Defective Reply dated 14 August 2002. The one month time period for responding to the Notification expires 14 September 2002.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date indicated below.



Signature of Person Mailing Paper

9/11/2002
Date

David E. Spaw
Printed Name of Person Mailing Paper

The present application names two joint inventors, Arno Kleinhaeni and Roman Mathiuet. One of the inventors, Arno Kleinhaeni, has reviewed the application and executed a Declaration, which is of record in the present application. The other of the inventors, Roman Mathiuet, has become unavailable and, therefore, the application is being filed under the provisions of 37 CFR 1.47(a), which states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Therefore, under the provisions of Rule 47(a), if a joint inventor cannot be reached after diligent effort, the application may be made by the other inventor on behalf of himself and the non-signing joint inventor. Accordingly, in the present application the signing inventor, Arno Kleinhaeni, has executed the application on his behalf and on behalf of the non-signing and unavailable inventor, Roman Mathiuet. The executed Declaration was filed with the original Petition on June 25, 2002, and is of record in the present application.

Rule 47(a) also requires that the Declaration be accompanied by a petition including proof of pertinent facts (of the diligent effort expended in attempting to locate the inventor), a petition fee, and the last known address of the inventor. With regard to the "diligence" requirement, or the pertinent facts, Rule 47(a) is generally silent. MPEP §409.03, although not binding authority (i.e., not from the United States Code, Rules of Practice, or federal court decision), may serve as a guide illustrating efforts that may establish "diligence" and in determining what "pertinent" facts may be proven.

Initially, it is noted that MPEP §409.03(a) states that:

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

Accordingly, this section of the MPEP tracks exactly on the requirements of Rule 47(a). Further, with regard to diligent effort and proof of facts establishing that such diligent effort was made, MPEP § 409.03(d) (pertinent part) states that:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the original Petition filed on June 25, 2002, (which is expressly incorporated herein), a Declaration signed by Mr. Willi Lanker, who is the assignee's patent attorney in Switzerland, detailed the efforts that were expended in attempting to locate Roman Mathiuet. These efforts included:

1. Registered letter sent to Roman Mathiuet's last known address. A copy of the letter and the envelope in which it was sent was attached to the Petition.

2. Telephone directories for Switzerland were consulted in an attempt to locate a telephone listing for Roman Mathiuet. No such telephone listing was contained in the telephone directories. Copies of relevant pages of telephone directories were attached to the Petition.

3. Contacting other people having the "Mathiuet" surname found in the telephone directories to see if they were related to Roman Mathiuet and could provide Roman Mathiuet's location. This effort resulted in identifying Roman Mathiuet's brother and father.

4. Attempting to convince Roman Mathiuet's brother and father to provide Roman Mathiuet's present location, telephone number, or contact information. These attempts were unsuccessful.

5. Contacting the registration office of the local administration, which sometimes has new contact addresses for Swiss citizens when they move. The registration office did not provide any contact information regarding Roman Mathiuet. A copy of the fax to the registration office was included with the Petition.

In submitting the Petition detailing the foregoing efforts to locate the missing inventor, Roman Mathiuet, it was sincerely believed that diligent efforts, and more than adequate proof of facts regarding the diligent efforts, were established within the meaning and spirit of the Rule. Clearly, much time was expended and several items of evidence (i.e., evidence listed in MPEP §409.03(d)) were attached to the Petition. However, the Petition was found to be defective and insufficient.

In telephone discussions between the undersigned and Erin M. Pender and, subsequently, between the undersigned and Boris Milef, it became apparent that the basis for rejecting the Petition, despite the prima facie establishment of diligent efforts to locate the missing inventor, was the fact that, in the Petition, it is stated that "Roman Mathiuet is on a trip around the world with unknown destination, unknown whereabouts and no contact address." This was interpreted by the PCT Legal Administration as meaning that Roman Mathiuet is on "vacation". Based

upon this interpretation, MPEP §409.03(d) was relied upon in finding that the Petition was defective. MPEP §409.03(d) states, in pertinent part, that "[t]he fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47."

It is submitted that, in this case, the reason for filing under 37 CFR 1.47 is that one of the joint inventors, Roman Mathiuet, cannot be found or reached after diligent effort. This fact has been established by documentary evidence and the declaration of someone having first hand knowledge of the facts and events detailed in the Petition. Simply put, Roman Mathiuet cannot be found and is unavailable to execute the Declaration for the present application. All reasonable efforts to locate Roman Mathiuet have been undertaken, and that is all that is required by 37 CFR 1.47. Accordingly, it is respectfully submitted that the original Petition satisfied all of the requirements of 37 CFR 1.47, and reconsideration of the decision embodied in the Notification of Defective Reply is requested.

Moreover, enclosed herewith is a Supplemental Petition and Statement executed by Mr. Willi Lanker and detailing further efforts made to locate Roman Mathiuet. These efforts include:

1. A registered letter, including a copy of the application as filed, was sent to Roman Mathiuet's last known address. The registered letter was undelivered, and was returned. A copy of the letter, an English translation of the letter, and the envelope is attached.
2. Swiss telephone directories were examined to identify a telephone number for Roman Mathiuet. No such telephone listing was found. Copies of pertinent pages of the telephone directories are attached to the Supplemental Petition.
3. A further fax to the Swiss registration office regarding the whereabouts of Roman Mathiuet. The registration office had no definite location for Roman Mathiuet, but indicated that he may be in Portugal. A copy of the fax is attached to the Supplemental Petition.

4. On-line telephone directories for Portugal were examined to find a telephone listing for Roman Mathiuet. No telephone listing for Roman Mathiuet was found. Copies of relevant portions of the telephone directories are attached to the Supplemental Petition.

5. Further attempts were made to contact Roman Mathiuet's brother and father, and to convince them to assist in locating Roman Mathiuet. A purported e-mail address for Roman Mathiuet was provided, but attempts to send e-mail to the address were unsuccessful. Copies of the e-mail messages are attached to the Supplemental Petition.

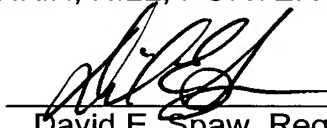
It is hereby submitted that, regardless of whether the original Petition was sufficient, the Supplemental Petition independently details the efforts made in attempting to locate Roman Mathieu and, when considered alone or in combination with the original Petition, satisfies the 37 CFR 1.47(a) requirements. Accordingly, the present application, which is made by Arno Kleinhaeni on his own behalf and on behalf of Roman Mathiuet, should be accepted. Notice to that effect is hereby requested.

It is believed that no fees are required by the present communication. However, If fees are required, please charge same to our Deposit Account No. 18-0160, our Order No. FRR-12782.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP

By


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